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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,790	08/27/2003	Clark Easter	026063-00014	4489

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,790

Applicant(s)

EASTER ET AL.

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 34-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Election filed 11/23/2005 to the original application filed 08/27/2003.
2. Claims 1-33 are currently elected for examination. Claims 1 and 21-22 are independent claims. Claims 34-46 are withdrawn from consideration.
3. Applicant is required to cancel non-elected claims 34-46 in the next response to this office action.

Priority

4. Examiner acknowledges the claims for domestic priority under 35 U.S. C. 119 (e) to provisional application 60/406046 which was filed 08/27/2002.

Election/Restrictions

5. Applicant's election without traverse of group I, claims 1-33 in the reply filed on 11/23/2005 is acknowledged.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. The language of claim 1-21 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.
8. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of software alone without claiming associated computer hardware required for execution, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application). Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts.
9. Claim 21 is rejected under 35 U.S.C. 101 because the claim does not appear to require any computer hardware to implement the claimed invention. This claim appears to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of claim 21 to support the “system” of the preamble. Likewise, the “system” of the preamble of claim 21 appears to be a system comprised entirely of software. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts.

Claim Rejections - 35 USC § 102

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10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-33 are rejected under 35 U.S.C. 102(b) as being anticipating by **Roper** (U.S. 6,270,351, issued 08/07/2001).

As to claim 1

Roper teaches a method for providing interactive assistance with populating an automated document that includes at least one field (*see the Abstract*), the method comprising:

- a. selecting an entity to which the document applies (*col.2, lines 1-44 & col.4, lines 32-44*);
- b. assigning a prioritization to each of the at least one field (*col.6, lines 16-20 & see item StudentID in fig.5*);
- c. prompting for a response for each of the at least one field, the prompting varying based on the prioritization of each of the at least one field (*col.6, lines 1-21*); and
- d. iteratively revising the prioritization of all of the at least one field upon receiving the response to each of the at least one field (*col.6, line 59-col.7, line 59*).

As to claim 2

Roper teaches the document is a form (*e.g., form; col.5, lines 20-25*).

As to claim 3

Roper teaches the form is used for compliance with educational requirements (*e.g., forms required by either or both local school districts and state departments of education; col.2, lines 26-30*).

As to claim 4

Roper teaches the educational requirements include requirements under the Individuals with Disabilities Education Act (*col.1, lines 16-34*).

As to claim 5

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*).

As to claim 6

Roper teaches performing a compliance check of each response for the at least one field (*e.g., form is checked to eliminate confusion; col.11, lines 53-67*).

As to claim 7

Roper teaches if the compliance check passes, providing an option to lock the document (*e.g., the system locks the individual education plan record in the individual education program database 18; col.13, lines 1-14 and see fig.1*).

As to claim 8

Roper teaches receiving a selection of a response to the option to lock the document; and

if the selection is to lock the document, preventing revision of each of the responses to the at least one field (*e.g., If the user selects the Lock This IEP option 1710, the system locks the individual education plan record in the individual education program database 18 from any further modifications; col.13, lines 1-13 and see fig.1*).

As to claim 9

Roper teaches prompting a user for security information (*e.g., enter a login ID and password; col.7, lines 15-16*).

As to claim 10

Roper teaches the entity is an individual (*e.g., an individual; see the Abstract*).

As to claim 11

Roper teaches storing the automated document with the response to each of the at least one field (*see figs. 9-11*).

As to claim 12

Roper teaches prompting for a response to each of the at least one field includes: variably highlighting each of the at least one field (*see figs. 7-8*).

As to claim 13

Roper teaches variably highlighting each of the at least one field includes: highlighting each of the at least one field in a color, the color varying with the prioritization of each of the at least one field (*see figs. 7-8*).

As to claim 14

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically

populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*); and highlighting each of the at least one field containing automatic populating (*see figs. 7-8*).

As to claim 15

Roper teaches prompting for a response to each of the at least one field is selected from, among other things, prompting for an optional response (*e.g., selection of the Enter/Edit Student Information of the main menu; col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

As to claim 16

Roper teaches selecting an entity to which the document applies includes: searching a repository containing at least one entity (*col.6, lines 22-58 and see fig.1*).

As to claim 17

Roper teaches providing an option to select the automated document form a plurality of documents (*col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

As to claim 18

Roper teaches generating the plurality of documents via a search (*col.5, line 59-col.6, line 58*).

As to claim 19

Roper teaches the automated document is associated with a meeting (*col.9, line 47-col.10, line 7 and see fig.12*).

As to claim 20

Roper teaches the meeting includes at least one event (*col.9, line 47-col.10, line 7 and see fig.12*).

As to claim 21

It is directed to a system for performing the method of claim 1 above, and is similarly rejected under the same rationale.

As to claim 22

The rejection of claim 21 above is incorporated herein in full. Additionally, Roper further teaches a processor (*e.g., the server 10; col.4, line 3*); a user interface (*e.g., Web server; col.4, line 20*); and a repository (*e.g., a central database; col.4, lines 52-53*).

As to claim 23

Roper teaches the processor is housed on a terminal (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 24

Roper teaches the terminal is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 25

Roper teaches the processor is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

As to claim 26

Roper teaches the server is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 27

Roper teaches the server is coupled to a network (*e.g., the network; col.4, lines 5-16 and see fig.1*).

As to claim 28

The use of the Internet is inherent to the system of Roper.

As to claim 29

Roper teaches the server is coupled to the network via a coupling (*col.4, lines 3-16*).

As to claim 30

Roper teaches the coupling is selected from a group consisting of a wired connection, a wireless connection, and a fiberoptic connection (*e.g., see fig.1 and the accompanying text beginning at col.3, line 63*).

As to claim 31

Roper teaches the repository is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

As to claim 32

It includes the same limitations as in claim 27, and is similarly rejected under the same rationale.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Plescia US Publication 2003/0113697 A1 Pub. Date: Jun. 19, 2003
- Wisnosky et al. US Publication 2003/0190593 A1 Pub. Date: Oct. 9, 2003

- David R. Olson, "Assent and Compliance in Children's language comprehension", Proceedings of the theoretical issues in natural language processing-2, ACM, July 1978, pp. 115-124.
- C. Heckman et al., "Designing Government Agents for Constitutional Compliance", Proceedings of the third annual conference on Autonomous Agents, ACM, April 1999, pp. 299-305.
- "www.4glsoftware.com", retrieved from the wayback machine, March 2001, pp. 1-22.

Contact information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore
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PRIMARY EXAMINER
2/5/2006